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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/661,587

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Kuo-Jung Hsu

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EXAMINER

SHERMAN, STEPHEN G

ART UNIT

PAPER NUMBER

2629

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/661,587	<b>Applicant(s)</b> HSU, KUO-JUNG	
	<b>Examiner</b> Stephen G. Sherman	<b>Art Unit</b> 2629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

1. This office action is in response to the amendment filed the 11 April 2006.

Claims 1-16 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Ramey et al. (US 6,756,971).

**Regarding claim 1**, Ramey et al. disclose a notebook computer with a hidden touch pad (Figure 8, notebook computer 30), comprising:

a main portion including a housing portion (Figure 8 can be seen to have a main housing portion 32.),

wherein the housing portion has an internal surface having an receiving portion (Figure 8. The surface 34 of housing 32 would have an internal surface, where the touch pad guard 60 would be a part of the housing 32, and the underside of surface 62, as better seen in Figure 9, would then be an internal surface of the housing. The inner surface of touch guard 60 would then be the portion of the internal surface of the housing. This internal surface would then have a receiving portion in order to has the touch pad close to the external area of the housing for a user to utilize the touch pad 12.);

a display connected to the main portion in a rotatable manner (Figure 8, computer screen 30 is connected to the housing 32 in a rotatable manner as explained in column 4, lines 28-45.); and

a touch pad disposed onto the receiving portion (Figure 8, touch pad 12 is disposed onto the receiving portion of the interior surface of the housing 32 near the top surface 34 to facilitate the user thereof.);

wherein the internal surface prevents the touch pad from being exposed to an atmosphere outside of the housing portion (Figures 8 and 9 show that when the touch guard 60 is in the closed position that the touch pad 12 is prevented from being exposed to an outside atmosphere of the housing portion 32.).

**Regarding claim 2**, Ramey et al. disclose the notebook computer as claimed in claim 1, wherein the housing portion further includes an external surface (Figure 8, the surface 34 can be seen to be an external surface of the housing portion 32.).

**Regarding claim 4**, Ramey et al. disclose the notebook computer as claimed in claim 1, wherein the receiving portion has a concave portion (Figures 8 and 9 show that of the internal surface of housing 32, as explained in the rejection of claim 1, has the touch guard 60 as part of the housing's structure, meaning that that interior surface of the touch guard 60 is part of the internal surface of the housing. The interior surface of the guard member 60 is then part of the receiving portion since it contacts the touch pad 12 when closed, meaning that when the touch guard 60 is in the opened position that the internal surface of the housing when the touch guard 60 is received would be a concave portion of the receiving area.).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramey et al. (US 6,756,971).

**Regarding claim 7**, Ramey et al. disclose the notebook computer as claimed in claim 1.

Ramey et al. fail to teach of the notebook computer wherein the thickness of the receiving portion is about 0.5-0.8mm.

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to make the thickness of the receiving portion between .5-.8 mm since a notebook computer is portable and it is important to have the overall size of the notebook computer be relatively small meaning that all the components located inside of the computer would also need to be small.

**Regarding claim 8**, Ramey et al. disclose the notebook computer as claimed in claim 1.

Ramey et al. fail to teach of the notebook computer wherein the difference between the thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing is about 0.7-1.0 mm.

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to “one of ordinary skill” in the art at the time the invention was made to make the difference between the thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing to be about 0.7-1.0 mm because it is important for the housing to keep a relatively small size but still be thicker than other components in the computer such that the internal components are protected properly.

***Regarding claim 9***, Ramey et al. disclose the notebook computer as claimed in claim 1.

Ramey et al. fail to teach of the notebook computer wherein a ratio between the thickness of the receiving portion and the thickness a portion, adjacent to the receiving portion, of the housing is about 1/3-1/2.

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to “one of ordinary skill” in the art at the time the invention was made to make the ratio between the thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing to be about 1/3-1/2 mm because it is important for the housing to keep a

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relatively small size but still be thicker than other components in the computer such that the internal components are protected properly.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ramey et al. (US 6,756,971) in view of Garner (US 6,501,462).

**Regarding claim 3**, Ramey et al. disclose the notebook computer as claimed in claim 2.

Ramey et al. fail to teach of a notebook computer wherein the housing further includes a flange on the external surface, and the flange surrounds the surface correspond to the receiving portion.

Garner discloses of a notebook computer wherein the housing further includes a flange on the external surface, and the flange surrounds the surface correspond to the receiving portion (Figure 1, item 39 and column 4, lines 5-12. The examiner interprets that item 39 is a flange which surround the touch pad portion item 35.).

Therefore it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to use the flange taught by Garner with the notebook computer taught by Ramey et al. in order to provide tactile feedback such that the touchpad can be found without looking for it with the eye.

9. Claims 5-6 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramey et al. (US 6,756,971) in view of Keely, JR. et al. (US 2002/0063694).



**Regarding claim 5**, Ramey et al. disclose the notebook computer as claimed in claim 1.

Ramey et al. fail to teach of the notebook computer further comprising: an adhesive member adhering the touch pad to the receiving portion.

Keely, JR. et al. disclose of a notebook computer further comprising: an adhesive member adhering a touch pad to the outer surface opening (Paragraph [0041]).

Therefore it would have been obvious to “one of ordinary skill” in the art at the time the invention was made to adhere the touch pad using adhesive as taught by Keely, JR. et al. to the outer edges of the receiving portion of the notebook computer taught by Ramey et al. in order to provide the desired stiffness, producing permanent alignment, shock control, the spread of impact forces along the edges, and liquid seal, with minimum cost, weight, and number of parts.

**Regarding claim 6**, Ramey et al. and Keely, JR. et al. disclose the notebook computer as claimed in claim 5.

Keely, JR. et al. also discloses wherein the touch pad is closely adjacent to the outer surface opening via the adhesive member, thereby eliminating any gap between the outer surface opening and the touch pad (Paragraph [0041]. The examiner interprets that when anything is sealed with an adhesive such that liquids are prevented from entering that the gap between the two items is eliminated.).

**Regarding claim 10**, this claim is rejected under the same rationale as claims 1 and 5.

**Regarding claim 11**, this claim is rejected under the same rationale as claims 5 and 6.

**Regarding claim 12**, this claim is rejected under the same rationale as claim 7.

**Regarding claim 13**, this claim is rejected under the same rationale as claim 8.

**Regarding claim 14**, this claim is rejected under the same rationale as claim 9.

**Regarding claim 15**, Ramey et al. and Keely, JR. et al. disclose the method as claimed in claim 10.

Ramey et al. and Keely, JR. et al. fail to teach of the method wherein the housing is formed by injection molding.

However, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to form the housing using injection molding since it is well known that the injection molding process has high production rates, allows design flexibility, has relatively low labor, and has minimum scrap losses.

**Regarding claim 16**, this claim is rejected under the same rationale as claim 4.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen G. Sherman whose telephone number is (571) 272-2941. The examiner can normally be reached on M-F, 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS

27 April 2006

AMR A. AWAD  
PRIMARY EXAMINER  
